

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 2 of 7

RECEIVED
CENTRAL FAX CENTER Attorney's Docket No.: 13817-005001
NOV 06 2006

REMARKS

Claims 1-41 are pending with claims 1, 16, 24 and 32 being independent. No claims have been amended. In view of the remarks below, reconsideration and allowance of all claims are requested.

35 U.S.C. 103(a) Rejections

Claims 1-23 and 32-41 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of U.S. Patent No. 6,622,017 to Hoffman ("Hoffman") and U.S. Patent Application Publication No. 2003/0032417 to Minear et al. ("Minear"). These rejections and their underlying reasoning are traversed.

Independent Claim 1:

With respect to claim 1, the proposed combination of Hoffman and Minear fails to disclose each and every feature of claim 1. For example, the Examiner concedes that Hoffman fails to disclose that *the subscription choices are sent to the mobile device over a wireless communication path, the subscription choices are for selection by a user of the mobile device, and the subscription choices comprise choices to initiate or modify a subscription to enable wireless communications over a wireless network* as recited in claim 1. The addition of Minear fails to alleviate the deficiencies of Hoffman.

The Examiner contends that Minear teaches the elements of claim 1 missing from Hoffman at ¶¶ [0005]-[0006], [0010]-[0014], [0023]-[0037] and FIGS. 1-5. However, the cited portions of Minear fail to support the allegation. For example, Minear does not disclose *sending the subscription choices to the mobile device over a wireless communication path* as required in claim 1. Instead, Minear is directed to a system for the "deletion and reloading of software application components on a wireless device." See Minear at ¶ [0023], ll. 1-4. The system in Minear deletes and reloads the software application components to provide an "efficient usage of the wireless device system resources such that the user can have ready access to a larger amount of executable software applications that can be completely stored on the wireless device." See Minear at ¶ [0016], ll. 11-19 (emphasis added). Thus, the system in Minear is directed to

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 3 of 7

Attorney's Docket No.: 13817-005001

controlling wireless device system resources, and it is unclear as to how such resources controlling in Minear is related to *sending any mobile service subscription choices to the mobile device over a wireless communication path* as recited in claim 1. In fact, Minear is silent as to any *subscription choices* being sent to a mobile device.

Further, a user of the wireless device in Minear would reasonably have had to purchase a qualifying *mobile service subscription*, from a wireless service provider, that allows the wireless device to access the internet or other resources before a desired software application can be downloaded. Thus, Minear suffers from the same deficiency as the previously cited Martin. Since the choice of a subscription in Minear presumably already has been made (otherwise, the wireless device would not be authorized to download any software applications) before receiving the selected phone, the user cannot send a request from the phone for subscription choices or receive the subscription choices on the phone as required in claim 1.

The Examiner also contends that Minear teaches that "users of wireless telephones can customize their wireless phones through the selective downloading of applications via the wireless network, and further teaches the users of wireless telephone desired to download applications to the wireless devices by using the BREW platform." See Office Action Dated July 5, 2006 at pg. 3, ll. 10-14. However, Minear is not directed to providing a system for selectively customizing users' wireless phones as alleged by the Examiner. In fact, Minear fails to teach or suggest a system of customization. As described above, Minear is directed to what happens once a user attempts to download a software application. Further, even if, arguendo, Minear could reasonably be construed to teach customizing wireless telephones, such customization would still fail to disclose or suggest each and every features of claim 1. For example, downloading a "chess 66 application" (see Minear at ¶ [0029], ll. 2) in Minear does not *initiate or modify a subscription to enable wireless communication over a wireless network* as recited in claim 1. The chess application in Minear, or for that matter any chess application, is merely a game, and the chess application does not *enable wireless communication over a wireless network* as recited in claim 1. Minear does not disclose or suggest that a software application, such as the chess application, are downloaded to *initiate or modify a subscription to enable wireless*

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 4 of 7

Attorney's Docket No.: 13817-005001

communication over a wireless network as recited in claim 1. Further, as set forth above, the wireless device in Minear must already have a qualifying *mobile subscription service* initiated or modified. Without having a *mobile subscription service*, the wireless device would not be capable of downloading any software applications.

For at least these reasons, claim 1 is patentable over the proposed combination of Hoffman and Minear.

Dependent Claims 2-15:

Claims 2-15 depend from claim 1, and thus are patentable over the proposed combination of Hoffman and Minear for at least the reasons set forth with respect to claim 1 above. In addition, claims 2-15 are patentable over the proposed combination of Hoffman and Minear for independent reasons.

In particular, the proposed combination of Hoffman and Minear fails to disclose or suggest *wherein the request for mobile subscription choices from the mobile device comprises an activation request* as recited in claim 2. While the Examiner alleges that Minear discloses the claimed feature at Col.3, ll. 48-67 and Col. 6, ll. 5-65, the cited portions of Minear fail to support the allegation. The *activation request* as recited in claim 1 is implemented, in one aspect, as a process for enabling access to ordinary and/or advanced cellular service. See Applicant's Specification at ¶ 0035, ll. 10-13. "Other than a minimal number of settings and initial activation instructions, however, settings and applications for enabling access to ordinary cellular service and/or to advanced services may be downloaded to the mobile device 405 over the air during or after the initial activation." *Id.* In addition, the *activation* process as claimed is clearly differentiated from the conventional activation process. See Applicant's Specification at ¶ 0040, ll. 7-10. "In a conventional activation process, such settings are entered by a clerk at the store where the mobile phone or calling plan is purchased. By using the described techniques, however, these settings may be provisioned in an over the air process." *Id.* Further, a mobile device *activation request* as recited in claim 2 is well known and understood in the art to describe the activation of the mobile device to enable access to mobile communication service.

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 5 of 7

Attorney's Docket No.: 13817-005001

In contrast to claim 2, Minear discloses managing the limited storage capacity in a wireless device through "selective deletion and reloading of individual software application components." See Minear at ¶ 0027, ll. 11-15. Thus, the system in Minear is directed to events (downloading software applications and managing storage space through selective deletion and reloading) that can occur only after the wireless device has been activated and enabled to access appropriate wireless communication services. In fact, Minear is not concerned about the process of initially activating the wireless device. Rather, Minear is limited to managing the limited storage space in the wireless device.

For at least this additional reason, claim 2 is patentable over the proposed combination of Hoffman and Minear.

Independent Claims 16 and 32:

Claims 16 and 32 should be allowable for at least reasons similar to claim 1 above.

Dependent Claims 17-23 and 33-41:

Claims 17-23 and 33-41 depend from claims 16 and 32, and thus are patentable over the proposed combination of Hoffman and Minear for at least the reasons set forth with respect to claims 16 and 32 above.

Independent Claim 24 and its dependent claims 25-31:

Claims 24-31 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the combination of Sears and Minear. These rejections and their underlying reasoning are traversed.

The proposed combination of Sears and Minear fails to disclose each and every elements of claim 24. The Examiner concedes that Sears fails to disclose *at least one memory storing an address of a server that stores settings data associated with at least one mobile service and storing client software for an application execution environment, wherein the at least one mobile service comprises a service to enable wireless communications over a wireless network* as recited in claim 24. The addition of Minear fails to alleviate the deficiencies of Sears.

As set forth with respect to claim 1 above, Minear does not disclose or suggest sending the subscription service choices to the mobile device for allowing the user to choose a

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 6 of 7

Attorney's Docket No.: 13817-005001

subscription service on the mobile device as required in claim 1. Instead, Minear is directed to efficiently organizing wireless device resources, which is wholly unrelated to *a service to enable wireless communications over a wireless network* as recited in claim 24. As set forth above, wireless communication over a wireless network must already have been enabled in Minear in order for the wireless device to download the software applications. Thus, the system in Minear can be possible only after the user has purchased the wireless device preconfigured by the selected mobile service provider or carrier. And because the phone in Minear must already be programmed for the particular mobile service provider, there is no need to store *an address of a server that stores settings data associated with at least one mobile service* as required in claim 24.

For at least these reasons, claim 24 is patentable over the proposed combination of Sears and Minear.

Dependent Claims 25-31:

Claims 25-31 depend from claim 24, and thus are patentable over the proposed combination of Sears and Minear for at least the reasons set forth with respect to claim 24 above.

Applicant : Anthony G. Macaluso
Serial No. : 10/682,312
Filed : October 8, 2003
Page : 7 of 7

RECEIVED Attorney's Docket No.: 13817-005001
CENTRAL FAX CENTER

NOV 06 2006

Conclusion


In view of the remarks, all of the claims are in condition for allowance. A formal notice to that effect is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply the one-month extension of time fee and any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: November 6, 2006



John C. Phillips
Reg. No. 35,322

Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

10678677.doc